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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/970,453 | 10/02/2001 | Shulamit Eyal | 20174C-002410US | 9637 |
| 20350 7590 08/06/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | | |
| EXAMINER | | | | |
| COOK, LISA V | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1641 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/970,453

Applicant(s)

EYAL ET AL.

Examiner

LISA V. COOK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

FINAL ACTION

Amendment Entry

1. Applicant's response to the office action mailed 01 January 2008 is acknowledged (paper filed 4/8/08). In the reply, claim 1 has been amended. Currently claims 1, 3-4, 7, and 10-13 are pending and under consideration. Claims 2, 5-6, 8-9 and 14-18 have been canceled at Applicants request.
2. Objections and/or rejections of record not reiterated below have been withdrawn.

NEW GROUNDS OF REJECTION NECESSITATED BY AMENDMENT

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 3-4, 7, and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Claims 3-4, 7, and 10-13 are rejected as being dependent on claim 1).
- A. Claim 1 is vague and indefinite because it is not clear as to how the measured "characteristic parameter" will be both independent of the flow velocity (see claim 1 step b) and simultaneously velocity dependent (see claim 1 step c).

The claim is further ambiguous in claim 1 step d, because the claim reads on normalizing of the velocity dependence measurement conducted in step b. However, claim 1 step b is directed to a characteristic parameter that is independent of the flow velocity and would therefore not be normalized to eliminate velocity because velocity is not measured.

It is suggested that the claim clearly recites the measurement of a velocity dependent and independent "characteristic parameter" or clearly identify how a single measurement of the "characteristic parameter of the analyte" independent of the flow velocity can also include velocity dependence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3-4, 7, and 10-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been modified to recite limitations regarding the measurement of a characteristic parameter which is independent of the flow velocity (claim 1 step b).

However, the claim further recites that the velocity independent measurement will be utilized to normalize and eliminate a velocity dependence measurement (claim 1 step d). The instantly claimed method appears to be a self contradiction and makes the claimed method internally flawed.

In addition, a method of measuring a velocity independent parameter that will subsequently eliminate velocity dependence is not taught by the specification. Nor is this method exemplified in the prior art. In other words the normalization of velocity which is not initially measured is not taught by the disclosure or prior art. The prior art teaches that these types of measurements are either velocity dependent or independent. For example, see Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790).

Support for the new limitations has not been clearly indicated in the instant disclosure. For example, page 2 lines 7-9 of the disclosure teaches method of normalizing fluorescent peaks (velocity dependent measurement) with particle velocity to obtain a velocity independent measurement of the fluorescent intensity. No evidence of normalizing a velocity independent measure is found. Accordingly, the newly submitted claim is considered new matter. Applicant is invited to show support for the limitation in the specification.

Response to Arguments

6. Applicant contends that the combination of Kopf-Sill (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. does not teach the measurement of the characteristic parameter that is *independent* of the flow velocity and subsequently normalized to eliminate a flow velocity dependent parameter. This argument was carefully considered and found persuasive in view of applicant's amendments to the claims, entered 4/8/2008. Accordingly the prior art rejections have been withdrawn.

7. For reasons aforementioned, no claims are allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The Group 1641 – Central Fax number is (571) 273-8300, which is able to receive transmissions 24 hours/day, 7 days/week. In the event Applicant would like to fax an unofficial communication, the Examiner should be contacted for the appropriate Right Fax number.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (571) 272-0816. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya, can be reached on (571) 272-0806.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Lisa V. Cook/
Examiner, Art Unit 1641

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